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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,230

04/07/2006

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EXAMINER

SANDERS, HOWARD J

ART UNIT

PAPER NUMBER

3653

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,230	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> HOWARD SANDERS	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Amendment received 12/08/08 was entered into the record.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “common axis” of claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites "at the same time in addition..." It is unclear what this means and what occurrences are at the same time. The shutter is switched to an open state to use a force of the second roller at the same time as what? The portion of the claim seems to be missing words crucial to understand the intended limitation. As no other time or occurrence was clearly listed the examiner is unable to treat the limitation to be synchronous with anything.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Takatoshi et al. US 5,755,434. Takatoshi et al discloses a bottom removal type paper supply apparatus having:

a paper support base (2) on which paper is stacked located at a bottom part of the bottom removal type paper supply apparatus;

force applying means (40) for applying pressure on the paper stacked on the paper support base;

a first pickup roller (51) provided at an end portion of the paper stacked on the paper support base, on a side toward a body of the bottom removal type paper supply apparatus and which picks a paper sheet from the paper stacked on the paper support base from the bottom and transports the paper sheet into the bottom removal type paper supply apparatus;

a second pickup roller (21) provided at a central portion of the paper stacked on the paper support base, and selectively assisting the first pickup roller to transport the paper sheet into the bottom removal type paper supply apparatus; and

a shutter (including 60) switchable between an open state in which the paper is in contact with the second pickup roller, and a closed state in which the shutter prevents contact between the paper and the second pickup roller, the shutter being provided on the second pickup roller (Column 5, lines 13-40), wherein

the shutter may be switched in the open state to use a paper transport force of the second pickup roller in addition to a paper transport force of the first pickup roller only when a prescribed weight or a prescribed number of sheets of paper are stacked

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on the paper support base, and the shutter may be switched in a closed state otherwise, to use only the paper transport force of the first pickup roller.

The pressure applied to the paper by the force applying means can be adjusted, including as explained from column 3, line 64 to column 4, line 28.

The shutter may be switched between the open and closed states based on sensing the stack weight or a pickup miss of the first pickup roller.

The shutter and the second pick-up roller have a common axis (for example parallel with (2) in Figure 10), the shutter has at least one first portion (the bottom of (60) in Figure 10) which extends to a larger distance from the axis than the pick-up roller, and at least one second portion (the top portion in Figure 10) which extends to a smaller distance from the axis than the same part of the pick-up roller (near the bottom of (60) in Figure 10). The at least one second portion is in contact with the paper stacked on the paper support base when the shutter is closed.

### ***Response to Arguments***

Applicant's arguments filed 12/08/08 have been fully considered but they are not persuasive. Applicant argued that feeding roller 51 of Takatoshi is not provided at an end portion of the paper stacked on the paper support base and that the roller is not in contact with the stacked bank notes. Applicant is directed to Figure 10 for example that illustrates the location precisely as claimed. As seen in the Figure the roller is in fact in contact with the stacked media and therefore may provide the features as listed in claim 1. It should also be noted that no such contact was actually claimed. Applicant further

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asserted that roller 21 of Takatoshi can not correspond to the second pickup roller for the same reason that the roller 51 does not contact a sheet on its own. As illustrated in Figure 10 the roller does in fact contact a sheet on the stack. Furthermore, it should be noted as the alternate scenario of 'either less than or equal to a prescribed weight or number of sheets are stacked' is the condition within which the argued portion of the claim occurs, were that scenario not to happen the limitations listed within are moot and can not be argued as providing patently distinct subject matter.

Applicant argued that stopper 60 of Takatoshi does not anticipate the shutter as claimed in claim 1. Applicant lists a scenario in which is mentioned a desired use of the shutter. In response, a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. See MPEP 2114. As the recited structure of the shutter is disclosed by Takatoshi, the rejection is considered proper. Similarly applicant's has argued that recited portions of claims 2-4 provide additional features. The Examiner notes that no additional structure is provided rather desirable scenarios or intended use of the structure is described. This is not sufficient to distinguish the claimed apparatus.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HOWARD SANDERS whose telephone number is

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(571)270-3096. The examiner can normally be reached on Mon - Fri, 7:15 AM - 4:45 PM EST, Alt. Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
Unit 3653

/H. S./  
Examiner, Art Unit 3653